

In particular, the Examiner asserts that the phrase “consisting essentially of” is “not appropriate for claims drawn to chemical structures” and that the “nature of substitutions to the recited chemical structure encompassed by the claim is unclear”. Applicants respectfully point out that the Federal Courts have taken a starkly different view of the use of the phrase “consisting essentially of” in a chemical claim.

The phrase “consisting essentially of” is a term of art used in chemical patent practice which has an accepted meaning. Its use leaves the claim open for the inclusion of unspecified ingredients which do not materially affect the basic and novel characteristics of the composition.

*Carter-Wallace, Inc v. Gillette Co.* 211 USPQ 499, 527 n. 29 (Mass. 1981) (citing *Application of Janakirama-Rao*, 317 F.2d 951, 952 (CCPA 1963). Also, the Examiner’s attention is respectfully drawn to a recent case decided by the Federal Circuit, entitled *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1573 (Fed.Cir. 1997) which deals with claims relating to DNA molecules and the use of the phrase “consisting essentially of” in claiming those DNAs. This case provides just one example. Many other similar US patents have issued from the USPTO. In fact, a simple search at the USPTO web site of “protein” and “consisting essentially” in the claims yielded over 1100 such issued US patents.

Further, *In re Garnero*, 162 USPQ 221, 223 (CCPA 1969), states that a claim to a product “consisting essentially of” enumerated components adequately distinguishes the product over reference products that require at least one additional component. Thus, the phrase “consisting essentially of” has a well-recognized meaning within the chemical and biochemical arts and its use distinguishes the claimed product over prior art products having at least one additional component.

Also, the Examiner asserts that the phrase “consisting essentially of” is to be interpreted as open claim language. This position is also contrary to the positions taken by the Federal Courts and the MPEP. As stated in *PPG Industries Inc. v. Guardian Industries Corp.*, 48 USPQ.2d 1351, 1354 (Fed. Cir. 1998),

A “consisting essentially of” claim occupies a middle ground between closed claims that are written in a “consisting of” format and fully open claims that are drafted in a “comprising” format. *See Ex parte Davis*, 80 USPQ 448, 449-450 (Pat. Off. Bd. App. 1948); *Manual of Patent Examining Procedure* §2111.03 (6<sup>th</sup> ed. 1997)

Similarly, *General Electric Co. v. Hoechst Celanese Corp.*, 16 USPQ.2d1977, 1979 no. 1 (Del. 1990), states:

In the lexicon of patent law, “comprising” leaves a claim open for the inclusion of unspecified ingredients; “consisting essentially of” restricts the inclusion of unspecified ingredients to those ingredients that do not “materially affect the basic and novel characteristics” of the claim.

Thus, it is well recognized in the patent law that “consisting essentially of” is not equivalent to “comprising” (as the Examiner asserts), but rather is partially closed language, which restricts the inclusion of unspecified ingredients to those that do not materially affect the basic and novel characteristics of the claim. Applicants respectfully request reconsideration and withdrawal of this §112 rejection.

Claims 29-31 have been rejected under 35 U.S.C. §102(b) as being anticipated by WO92/21767. Applicants respectfully disagree with this rejection.

The cited reference describes a peptide containing more than 5-20 amino acids. The claims as written use partially closed language, which necessarily excludes fragments of the gp100 molecule disclosed in the cited reference. Thus, applicants assert the cited prior art reference is not an anticipating reference under 35 U.S.C. §102(b). Furthermore, this art does not

render the claims obvious because there is no teaching or suggestion of specific shorter fragments of gp100. Reconsideration and withdrawal of this rejection is respectfully requested. Applicants respectfully request reconsideration and urge that the present claims are in condition for allowance. Early and favorable action is earnestly solicited.

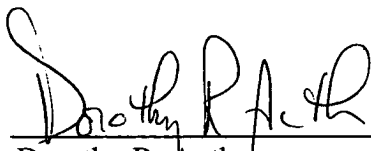
No additional fee is believed to be necessary.

The Commissioner is hereby authorized to charge any additional fees which may be required for this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2026-4124US3.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition and for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 2026-4124US3. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

By:   
Dorothy R. Auth  
Registration No. 36,434

Dated: January 24, 2000

MORGAN & FINNEGAN, LLP  
345 Park Avenue  
New York, New York 10154  
(212) 758-4800  
(212 751-6849 Telecopier